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IN THE SUPREME COURT

Supreme Court of the United States

October Term, 1970

No. ...

HUGH R. ANN PRICE, Executrix,

Petitioner

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC., *et al.*,

Respondents

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Supreme Court of the United States

OCTOBER TERM, 1960

No. .....

HELEN RUSSELL PIERCE, Executrix,

Petitioner

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC., *et al.*,

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Petition Is Without Merit

Question I

The main basis of the petition is an alleged conflict between the decisions of the Courts of Appeals for the First and Fifth Circuits with respect to validity of certain Pierce patents.

There is no conflict between the decisions of the First and Fifth Circuits (printed respectively at pages 13 and 35 of the Petition) such as to justify this Court taking jurisdiction of the case.

The first decision in time (May 12, 1958), was that of the Fifth Circuit, *Pierce v. Aeronautical Communications Equipment, Inc.*, 255 F. 2d 458, which involved an appeal

from a summary judgment that had invalidated the Pierce patents. The Florida District Court in that case had not prepared an opinion but merely entered a judgment to the effect that the Pierce patents were invalid. The Court of Appeals reversed the summary judgment and sent the case back to the lower court for a trial on the merits because the court felt that "plaintiff is entitled to a considered opinion by the district court . . . " (p. 461) and "From the status of the record regarding these patents it does not appear that these patents received the consideration from the court to which they were entitled and the case was not, therefore, ripe for summary judgment" (p. 462). Thereafter, and purely by way of dictum, the court stated that the reasoning in *American Communications Co.* v. *Pierce*, 208 F. 2d 763, and *Pierce* v. *Hewlett-Packard Co.*, 220 F. 2d 631, of the Court of Appeals for the First Circuit "even if valid concerning double patenting, when placed together, do not necessarily preclude plaintiff's success in this case." (p. 462). The Fifth Circuit thought that Pierce should be afforded the opportunity of proving the invalidity of his own expired patent No. 1,789,496, whose validity and infringement were never in issue, in order to overcome the double patenting defense. The erroneousness of the Fifth Circuit's belief that one can attack the validity of his own patent is apparent. The correctness, however, of that belief need not concern us because the fact is that *the Fifth Circuit's decision contains no holding of validity or infringement of any of the Pierce patents.*

Contrast that with the situation in the present case where both the district court and the Court of Appeals filed extensive, carefully prepared opinions holding the Pierce patents invalid for numerous reasons.

We will not go into the reasons which support the decisions in the First Circuit and establish them as being just

and eminently sound in law. Suffice it to say that at least on two prior occasions petitioner unsuccessfully petitioned this Court in an attempt to reverse the main basis of the present decision. *Pierce v. American Communications Co.* (*supra*), cert. denied 347 U. S. 970, 348 U. S. 851; *Pierce v. Hewlett-Packard Co.* (*supra*), cert. denied 350 U. S. 833.

According to the authority relied upon by petitioner (Petition, pp. 2, 3) "Robertson and Kirkham Jurisdiction of the Supreme Court of the United States" by Wolfson and Kurland, 1951, § 354, p. 705, in order for this Court to consider granting certiorari in a patent case there must be a *direct* conflict of decisions between courts of appeals as to validity: As previously discussed, no such conflict exists because while the First Circuit invalidated the patents, the Fifth Circuit merely remanded for trial on the merits.

This case does not present any "real and embarrassing conflict" as to validity of particular claims such as would warrant granting of the petition. *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393, 43 S. Ct. 422, 67 L. Ed. 712. The issues in this case involve only what the Court has termed to be ordinary issues of validity. *Layne & Bowler Corp. v. Western Well Works* (*supra*); *Keller v. Adams-Campbell*, 264 U. S. 314, 319, 44 S. Ct. 356, 68 L. Ed. 705.

Petitioner is here seeking to have the Court review evidence and discuss facts which rest on concurrent findings of two lower courts. The Court has consistently refused to grant a writ in such a situation. *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175, 58 S. Ct. 849, 82 L. Ed. 1273; *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 64 S. Ct. 593, 88 L. Ed. 721.

Stern and Gressman in "Supreme Court Practice", second edition, point out, page 111, that in a growing number

of cases even where there is a "square and irreconcilable" conflict between decisions of courts of appeals the Supreme Court has denied certiorari. This is particularly justified where, as in the present case, all of the patents in suit expired years ago and the issue involved is no longer a live one. See also 66 Harv. L. Rev. 465 (1953).

Question II

Petitioner complains that with respect to three of the Pierce patents summary judgment was improper. Rule 56 of the Federal Rules of Civil Procedure was designed for just such a situation as existed in the present case. The Court of Appeals fully answered petitioner's complaint as follows (Petition, pp. 24, 25):

> "As to these last three patents the plaintiff-appellant contends that summary judgment was improper and that she should have been allowed to present evidence on the issue of their validity at a trial. We are at a loss to perceive what evidence in addition to that before the court below would shed any further light on the issue. Nor do counsel for the plaintiff-appellant in their brief tell us what additional evidence they would like to present. They merely assert in their brief that they have additional evidence, and in their reply brief complain that they would have expatiated further on the question of the validity of these three patents had this court not limited their brief to 160 pages. The simple answer to this is that if they had directed their argument to essential basic issues instead of posing and repetitiously arguing twenty-eight more or less irrelevant separate questions, they would have had ample opportunity to present their argument to this court on these three patents within the space allowed them."

CONCLUSION

For the foregoing reason it is prayed that the petition be denied.

Respectfully submitted,

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